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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/921,141 | 08/03/2001 | Hiroshige Kikuchi | 500.40416X00 | 6408 |

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| EXAMINER | |
|---|---|
| JASMIN, LYNDA C | |
| **ART UNIT** | **PAPER NUMBER** |
| 3627 | |

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/921,141 | KIKUCHI ET AL. | |
| | Examiner | Art Unit | |
| | Lynda Jasmin | 3627 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *13 January 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *21-43* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-43* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

1. Amendment received January 13, 2006 has been acknowledged.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 21-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mise, in view of Yablonowski et al.

Mise discloses an information electric appliance renting system for leasing information electric appliances to a plurality of individual use contractors, comprising: at least one information electric appliance (such as living facilities; ¶ 0024, 0025) which is leased by a service providing company (2) via service provider to respective ones of a

plurality of individual use contractors (contracted customers), and a rent managing server (3) of the service providing company for managing the leased information electric appliances (11) of the service providing company (22), wherein the at least one information electric appliance has communication means for sending including electric power consumed thereby to the data rent managing server (¶ 0042), wherein the data sent by the at least one information electric appliance to the rent managing server further includes information relating to at least one of manufacture and use of the at least one information electric appliance (such monitoring for abnormal operation; ¶ [0035]).

Mise further discloses the rent managing server includes judgment means for judging the data sent from the at least one Information electric appliance carrying out a judgment of abnormality of the at least one information electric appliance and for judging on a basis of a judgment result whether or not maintenance needs to be carried out (¶ [0010]). Further, the rent managing server includes means for generating a running pattern on a basis of the data sent from the at least one information electric appliance to compare a total cost up to a scrapping processing of the at least one information electric appliance with a total cost up to a scrapping processing of an information electric appliance which is replaceable with the at least one information electric appliance to execute the replacement judgment for the at least one information electric appliance (¶ [0079]).

However, Mise fails to explicitly disclose a managing server having communication means for receiving the data sent from the at least one information

electric appliance so that the service providing company receives from the plurality of individual use contractors payment of the rent and pays an electric power company an amount corresponding to the total consumed electric power of the leased information electric appliances of the combined individual use contractors.

Yablonowski et al. discloses the concept of charging a fee to a user where a service company services a lighting system to the user's facility. The fee is charged to the end user, such that the fee is a function of a difference between the original power consumption and the new power consumption. For example, the fee from the end user to the service company is forty cents where the original electric utility cost was one dollar (as illustrated in FIG. 1) and the new electric utility cost is sixty cents. Yablonowski et al. further discloses the fee is the difference between the original power consumption and the new power consumption multiplied by actual hours of operation, multiplied by a power rate, and multiplied by an air conditioning reduction factor. The hours of operation, the power rate and the air conditioning reduction factor may be determined through negotiation. Other calculations may be used to suit the specific requirements of the end user and the service provider, such as a fee comprising only a portion of the reduction.

From this teaching of Yablonowski et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modify the monitoring of equipment of Mise to include the fee charge to the user and the payment of electric utility as taught by Yablonowski in order to provide energy saving.

***Response to Arguments***

5. Applicant's arguments filed January 13, 2006 have been fully considered but they are not persuasive.

Applicants argue "that all claims present in this application patentably distinguish over Mise and Yablonowski et al taken alone or in any combination thereof in the sense of 35 USC 103". The Examiner respectfully disagrees. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Yablonowski et al. discloses the concept of charging a fee to a user where a service company services a lighting system to the user's facility. The fee is charged to the end user, such that the fee is a function of a difference between the original power consumption and the new power consumption. For example, the fee from the end user to the service company is forty cents where the original electric utility cost was one dollar (as illustrated in FIG. 1) and the new electric utility cost is sixty cents. Yablonowski et al. further discloses the fee is the difference between the original power consumption and the new power consumption multiplied by actual hours of operation, multiplied by a power rate, and multiplied by an air conditioning reduction factor. The hours of operation, the power rate and the air

conditioning reduction factor may be determined through negotiation. *Other calculations may be used to suit the specific requirements of the end user and the service provider, such as a fee comprising only a portion of the reduction.* Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modify the monitoring of equipment of Mise to include the fee charge to the user and the payment of electric utility as taught by Yablonowski in order to provide energy saving.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sasao et al. and Jenkins et al. are cited as art of interest.

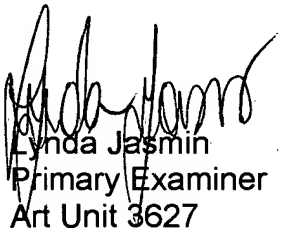
7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda Jasmin whose telephone number is (571) 272-6782. The examiner can normally be reached on Monday- Friday (9:30-6:00) with Thursday Telework.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lynda Jasmin
Primary Examiner
Art Unit 3627

lj